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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,418

04/12/2004

Paul A. Vaughan

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24347

7590

04/24/2009

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INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

LEWIS, RALPH A

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

04/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,418	VAUGHAN, PAUL A.	
	Examiner	Art Unit	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Acknowledgement of Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2009 has been entered.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 13-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Sevrain (US 2003/0135216).

Sevrain discloses a vertebral stabilization assembly having a vertebral screw 10 with a threaded opening in the shaft thereof for threadingly engaging a connecting

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screw 20. In regard to the apparatus claims (e.g. claim 2) indicating that the screws are configured to enter from the anterior side of the vertebrae, it is noted that the Sevrain screws are capable of such a use. In regard to claim 7, note connecting member "P." In regard to claim 21, the lower screw 10 is capable of being used as a bore screw for the upper pedicle screw 10. In regard to claim 22, the screw driver used to insert the Sevrain screws of claim 22 and the plate P can be considered the second claimed tool/guide member. In regard to claims 27 and 28, the threaded engagement between the the Sevrain screws 10 and 20, meet each of the vague "tensioning mechanism", "locking mechanism", and "keyed mating arrangement" limitations

In response to the present rejection applicant argues that the independent claims call for "an engaging portion comprising an opening formed in a lateral surface of the shaft and extending partially through the shaft" and argues that the threaded opening in vertebral screw 10 of Sevrain extends completely through the vertebral screw and not "partially" as claimed. Perhaps applicant would have an argument if applicant were claiming an engaging bore that was closed at one end, but applicant has chosen to only broadly claim a "portion." The examiner interprets the first half of the bore in the Sevrain screw 10 in which screw 20 is received as the "engaging portion." The second half of the bore is not interpreted as part of the "engaging portion." The examiner interprets the term "portion" to mean a part of a larger structure. A pie is made up of a number of portions and a whole pie reads on a claim calling for one or more portions even though it may contain "portions" that are not specifically claimed. Moreover, it is noted that applicant uses the open term "comprising" when setting forth the vertebral

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stabilization assembly which indicates that the assembly may include elements (or “portions”) that are not specifically claimed. See MPEP 2111.03 for guidance.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevrain (US 2003/0135216).

Sevrain illustrates the vertebral and connecting screws being inserted from the posterior side toward than anterior side as required by the present method claims. One of ordinary skill in the art would have found it obvious to insert the screws from the anterior side so that the anterior side of the vertebrae can be stabilized.

In response to the present rejection applicant argues that “Sevrain fails to mention the use of any type of a guide member that couples to a shaft of a vertebral screw, let alone a guide member that is then used to insert a connecting screw an anterior side of a vertebra.” The examiner notes that a common screwdriver may obviously be used to couple to the head of the Sevrain screws to guide the screws into position. Applicant’s broad limitations read on a conventional screwdriver which would inherently, or at least obviously, be used to insert and guide the Sevrain screws into position.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
April 23, 2009

/Ralph A. Lewis/
Primary Examiner, Art Unit 3732